

R E M A R K S

Applicant thanks the Examiner for the thorough consideration given the present application. Claims 1-8 are pending. Claims 1 and 2 have been amended, and claims 1 and 2 are independent. Reconsideration of this application, as amended, is respectfully requested.

Interview

Applicant further thanks the Examiner for the time and courtesy extended to Applicant's representative during the personal interview on November 5, 2003.

During the interview, it was agreed that the further functional language describing the patentable differences between the claims and the art of record could be found in the specification on page 21, line 17 to page 22, line 9. Accordingly, claims 1 and 2 have both been amended to recite that "the light separating device is divided into at least the first area and the second area, wherein the areas having different gradient pitches, by a dividing line which is substantially perpendicular to a tracking direction of the optical recording medium, wherein the light incident on the

areas being directed to different light receiving regions of the light detector".

The Examiner indicated that, upon introducing this language into the independent claims 1 and 2, he will consider these features because these features are not found in the prior art.

Rejection under 35 U.S.C. §103(a)

Claims 1-8 are rejected under 35 U.S.C. §103(a) as being unpatentable over JP 09-312033 (Koki) in view of U.S. Patent No. 6,243,350 to Knight et al. Applicant respectfully traverses this rejection.

To establish *prima facie* obviousness, all claim limitations must be taught or suggested by the prior art and the asserted modification or combination of prior art must be supported by some teaching, suggestion, or motivation in the applied reference or in knowledge generally available to one skilled in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Thus, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). The prior art must suggest the

desirability of the modification in order to establish a *prima facie* case of obviousness. *In re Brouwer*, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1995). It can also be said that the prior art must collectively suggest or point to the claimed invention to support a finding of obviousness. *In re Hedges*, 783 F.2d 1038, 1041, 228 USPQ 685, 687 (Fed. Cir. 1986); *In re Ehrreich*, 590 F.2d 902, 908-09, 200 USPQ 504, 510 (CCPA 1979).

▪ **Claim 1**

Claim 1 clearly states that the wavelength of light from the light source may be selected as part of the thermal compensation scheme. This has the advantage of increasing the number of parameters available in designing the temperature compensation of the apparatus.

Knight offers no indication that the wavelength of light may be chosen so as to reduce the effect of temperature on performance, nor does Knight teach or suggest that the wavelength of the light itself at standard operating temperature may be used as a parameter for temperature compensation.

Independent claim 1 further recites that a "distance of movement of the focal point on the light detector in a direction perpendicular to the second direction is within a prescribed

tolerance limit", and that "the light separating device is divided into at least the first area and the second area, wherein the areas have different grating pitches, by a dividing line which is substantially perpendicular to a tracking direction of the optical recording medium, and the light incident on the areas being directed to different light receiving regions of the light detector".

The thermal compensation scheme disclosed by Knight is directed to compensating for different properties from the present invention. Knight does not describe any relationship between the focusing error signal and thermal correction. As such, Knight does not teach or suggest the above-noted aspects of the present invention.

Furthermore, Koki does not teach or suggest the above-described features of the present invention, and there is no indication that these features would be known to one skilled in the art.

▪ **Claim 2**

Claim 2 recites that "the second direction is inclined so that when the focal point on the light detector moves while having a component of the direction perpendicular to the second direction because of a change in the wavelength of the light emitted by the

light source and expansion or contraction of the base, which are both caused by a temperature change".

The advantage of this feature is that it provides an optical pickup apparatus for accurately recording and/or reproducing information even when the temperature changes.

Additionally, claim 2 recites that "the light separating device is divided into at least the first area and the second area, wherein the areas have different grating pitches by a dividing line which is substantially perpendicular to a tracking direction of the optical recording medium, and the light incident on the areas being directed to different light receiving regions of the light detector".

Neither Koki nor Knight describes inclining the second line so as to maintain the movement of a focal point perpendicular to a second line within a prescribed tolerance, where such movement is caused by a temperature-induced change in wavelength and expansion or contraction of a base.

Furthermore, Knight is silent about the division of light detectors into regions and the orientation thereof.

CONCLUSION

It is respectfully submitted that Knight and Koki fail to disclose or render obvious the present invention as set forth in independent claims 1 and 2. Accordingly, reconsideration and withdrawal are requested of the rejection under 35 U.S.C. §103(a). Independent claims 1 and 2 are believed to be allowable. Since the remaining claims depend directly or indirectly from these allowable independent claims, they should also be allowable for at least the reasons set forth above, as well as for the additional limitations provided thereby. Therefore, all pending claims should be in allowable.


Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Daniel K. Dorsey (Reg. No. 32,520) at the telephone number of the undersigned below.

Appl. No. 09/801,646
Docket No. 0717-0462P
Reply to Office Action of August 25, 2003
Page 15

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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TCB/DKD: bmp
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Attachment(s)

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